

REMARKS

Claims 1-44 are pending.

Claims 1-44 stand rejected.

Claims 1, 20, 40 and 42-44 are independent.

Claims 1, 20, 40 and 42-44 are currently amended.

Restriction requirement

The Office Action mailed March 17, 2008, required restriction between the following allegedly distinct species:

Claims 1, 6, 7, 20, 26, 27 and 40-42 are generic.

Species 1: Claims 11-17 and 31-37

Species 1a: Claims 12 and 32

Species 1b: Claims 14 and 33

Species 1d: Claims 15-16, 34-35

Species 2(a-c): Claims 2-5, 18-19, 23-25, 38 and 39

Species 3: Claims 8 and 28

Species 4: Claims 9 and 29

Species 5: Claims 10 and 30

Species 6: Claims 21 and 22

Applicants provisionally elected Species 1a with traverse, which includes at least generic claims 1, 6, 7, 20, 26, 27 and 40-42 and Species 1a claims 12, 32, 43 and 44. In addition, Applicants noted that the remaining claims should also be examined because a search of species 1a would include a search of all the limitations of the other species. Applicants requested that the restriction requirement be withdrawn because serious burden had not been established.

The present Office Action does not acknowledge Applicants' election, does not refer to the restriction requirement at all. Because all of claims 1-44 have been examined on the merits, Applicants assume that the restriction requirement has been withdrawn. Applicants respectfully request that the next Office Action confirm Applicants' understanding.

Claim Rejections Under §103

Claims 1-44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,632,141 to Webb (“Webb” hereinafter) in view of U.S. Patent No. 6,506,118 to Baerlocher (“Baerlocher” hereinafter). This rejection is respectfully traversed.

The rejection itself is unclear as to which claims are being referred to at any given point, let alone which limitations are being referred to. As such, no *prima facie* case of obviousness for any claim can be discerned from the Office Action because no claim-by-claim analysis has been performed. The Office Action’s failure to do so is particularly egregious given the length and detail of a number of pending claims. For this reason alone, the rejection should be withdrawn and the claims allowed.

Further, Webb and Baerlocher are both directed to bonus games and do not meet the limitations of Applicants’ claims. Numerous deficiencies of Webb and Baerlocher are discussed in detail below.

Claims 1-19

With respect to claim 1, Webb and Baerlocher both fail to disclose game play that “comprises a predetermined number of rounds.” Webb and Baerlocher disclose a standard slot game in which each wager pays for a single game play only. The Webb contains a bonus round, but these rounds are of indeterminate length, and further, there is no way to pre-pay for a specific number of rounds of a bonus game or even to guarantee entry into the bonus round at all. The Office Action does not allege that Baerlocher meets any limitation of claim 1, including this and other limitations described below.

Webb and Baerlocher also fail to disclose a wager that is “an amount sufficient to pre-pay for [a] predetermined number of rounds.” Because the bonus game of Webb contains an indefinite number of rounds, the wager for a single primary game is entirely unrelated to the number of rounds in a bonus game of indeterminate length.

Further, even if the bonus game of Webb met the above limitations (and it does not), Webb and Baerlocher do not disclose “an initial balance of winnings”. The Office Action appears to rely on Fig. 3a-i of Webb as disclosing an initial balance of winnings, but no such disclosure exists. The “offer” 162 of Webb is not a “balance of winnings” at all, but is mere that:

an offer. Not until the player accepts the offer or the bonus rounds ends is any balance of winnings awarded.

Webb and Baerlocher do not show any situation in which an “initial balance of winnings” is ever adjusted prior to becoming a “final balance of winnings,” let alone based on a “predetermined subset” of the predetermined number of rounds. Webb’s “offer” can be redeemed at any time. Claim 1, on the other hand, requires that a predetermined number of rounds be completed before a player may receive the final amount.

Claim 2 makes this arrangement even more explicit, reciting that “the player is unable to cash out the current balance of winnings until after the predetermined number of rounds has been concluded.” The Office Action admits at page 4 that this limitation is not shown by Webb or Baerlocher. However, the Office Action ignores the reasons why such an arrangement is omitted, and simply uses hindsight reasoning to conclude that “[p]roviding a player with the inability to cash out is simply a matter of DESIGN CHOICE.” (emphasis in original). The Office Action’s use of caps lock notwithstanding, the cited references would not work if the Office Action’s proposed modifications were made to Webb because Webb is directed to an entirely different type of game that depends on the ability of the player to cash out at any time to function properly. Applicants are unaware of any authority that permits the Office Action’s inability to shoehorn an incompatible limitation into an incompatible reference relying only on Applicants’ specification as a roadmap.

Accordingly, the rejection of claim 1 and all dependent claims should be withdrawn and the claims allowed.

Claims 20-39

With respect to claim 20, and for at least the same reasons detailed above, Webb and Baerlocher both fail to disclose game play that “comprises a predetermined amount of time,” “an initial balance of winnings,” reducing the initial balance of winnings based on at least one outcome, and “determining, . . . at the end of a predetermined subset of the predetermined amount of time, a final balance of winnings based on the current balance of winnings at the time after the predetermined subset of the predetermined amount of time.”

The Office Action does not identify any limitation of Webb or Baerlocher that discloses these time-based features. Further, as discussed above, modifying Webb and Baerlocher to

prevent cashout as recited in claim 21 would render the underlying references nonfunctional and therefore cannot be “DESIGN CHOICE.”

Accordingly, Applicants respectfully request that the rejection of claims 20 and all dependent claims be withdrawn and the claims allowed.

Claims 40 and 41

Claim 40 recites, *inter alia*, “establishing, at the initiation of a game play at a gaming device, an initial value of a prize via the gaming device, wherein the game play ends once at least one of a predetermined number of rounds of the game are completed and a predetermined amount of time has passed, adjusting, via the gaming device, the initial value of the prize based on the determined outcomes, thereby determining a current value of the prize, wherein at least one of the determined outcomes causes the current value of the prize to be less than the initial value of the prize” and “determining, via the gaming device once the game play ends, a final value of the prize.

Webb and Baerlocher do not discloses these limitations, particularly that game play ends once predetermined number of rounds or amount of time is completed, and that the final value is only determined once game play ends. Accordingly, the rejection of claims 40 and 41 should be withdrawn and the claims allowed.

Claims 43 and 44

Independent claims 43 and 44 both recite the limitation that “the player is unable to cash out the current balance of winnings until after the predetermined number of rounds has been concluded,” discussed above with respect to claim 2. Accordingly, for at least these reasons, the rejection of claims 43 and 44 should be withdrawn and the claims allowed.